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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,580	06/20/2001	Naohiko Moriyama	AAO-255	1490

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EXAMINER

CHORBAJI, MONZER R

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,580

Applicant(s)

MORIYAMA ET AL.

Examiner

MONZER R. CHORBAJI

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-13 and 19 is/are allowed.
- 6) ☒ Claim(s) 1 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 2-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/17/2004.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 03/24/2005.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This non-final office action is in response to the amendment received on 01/26/2005

Remarks

1. The nonstatutory double patenting rejections along with the obvious rejections issued in the action dated 09/08/2004 have been withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 18; applicant recites, "a tank for receiving and containing the substances dissolved in the sprayed water." The tank in the recited phrase does not show any structural connection to the rest of the apparatus. For example, "a tank connected to said receiving member for receiving and containing the substances dissolved in the sprayed water" shows a structural relationship with the claimed device.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1744

4. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Gacki et al (U.S.P.N. 4,197,942).

With respect to claim 14, the Gacki reference, which is in the art of mixing prepackaged vessels with water, teaches a cylindrical cutter (figure 4b, 88) having a cutting edge (figure 4a, 95A and col.10, lines 58-59) along the inclined end (the inclined end in figure 4a being the entire edge including 95b) with a slit (figure 4b, 92) extending from the inclined end into the cutter body. Further, the Gacki reference teaches that the cylindrical cutter is constructed by rolling a flat sheet (col.11, lines 8-11) such that a rolled flat sheet results in a hollow cylindrical cutter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gacki et al (U.S.P.N. 4,197,942) as applied to claim 14 and further in view of Bernstein et al (U.S.P.N. 5,366,114).

The teachings of the Gacki reference have previously been set forth with respect to claim 14, but with regard to claim 15, the Gacki reference fails to teach a cutter with a serrated portion along the inclined end. The Bernstein reference, which is in the art of dispensing, sealed containers by piercing through a frangible membrane, teaches the use of a cutter with a serrated edge (figure 5, 44 and 54). As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cutter of the Gacki reference by including a serrated portion as taught by the Bernstein reference since a cutter with a partial serrated edge prevents the membrane from falling into the liquid by keeping a portion of the membrane in connection with uncut portion (col.3, lines 63-67).

The teachings of the Gacki reference have previously been set forth with respect to claim 14, but with regard to claims 16-18, the Gacki reference fails to teach a cutter with a serrated portion along the inclined end. The Bernstein reference, which is in the

Art Unit: 1744

art of dispensing, sealed containers by piercing through a frangible membrane, teaches the use of a cutter with a partial serrated edge (figure 5, 44, 54 and 56). The Bernstein reference teaches that the non-serrated portion (figure 5, 56) maintains the membrane in connection with the uncut portion after piercing the frangible membrane (col.3, lines 63-67). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cutter of the Gacki reference by including a partial serrated portion as taught by the Bernstein reference since determining the portion of the serrated edge of the cutter depends on the liquid dispensing rate.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gacki et al (U.S.P.N. 4,197,942) in view of Bernstein et al (U.S.P.N. 5,366,114) as applied to claim 15 and further in view of Taylor (U.S.P.N. 3,581,605).

The teachings of the Gacki reference have previously been set forth with respect to claim 14, but with regard to claim 18, the Gacki reference fails to teach a cutter with a serrated portion provided along the inclined end. The Bernstein reference, which is in the art of dispensing, sealed containers by piercing through a frangible membrane, teaches the use of a cutter with a partial serrated edge (figure 5, 44, 54 and 56), but fails to teach a cutter with serrations all around the edge. The Taylor reference, which is in the art of dispensing, pre-filled and sealed containers, teaches a cutter with serrations all around the edge (figure 1, 9). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cutter of the Gacki reference by including serrations all around the edge of the cutter as taught by

Art Unit: 1744

the Taylor reference in order to insure complete severance of the membrane from the container neck (col.3, lines 35-39).

Allowable Subject Matter

10. Claims 2-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 10-13 and 19 are allowed.

Response to Arguments

13. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

The newly applied reference, Gacki et al (U.S.P.N. 4,197,942) shows a slit extending from the inclined end into the cutter body (figure 4b, 88 and 92).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R. CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 6:30-3:00.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN KIM can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1744

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monzer R. Chorbaji *MRC*
Patent Examiner
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03/30/2005

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